



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#45

In re PATENT Application of Mills

Group Art Unit: 1745

Application Ser. No. 09/009,294

Examiner: Kalafut

Filed: January 20, 1998

For: HYDRIDE COMPOUNDS

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June 11, 2002

**SECOND REQUEST FOR  
RECONSIDERATION OF DECISION ON PETITION**

Hon. James E. Rogan, Director  
United States Patent and Trademark Office  
Washington, D.C. 20231

Director Rogan:

Applicant respectfully submits this Second Request for Reconsideration of the Decision on Petition (Paper No. 37) denying Applicant's initial request to withdraw the finality of the Office Action dated July 3, 2001.

This second request is necessitated by Director Jacqueline M. Stone's supplemental Decision on Petition dated May 15, 2002 (Tab 1), which failed to address the specific grounds for withdrawing finality that were articulated in Applicant's original Petition (Tab 2), and reiterated in Applicant's First Request for Reconsideration (Tab 3). Rather than properly consider those grounds, the May 15 Decision instead misapplies erroneous findings of fact to PTO procedural guidelines that actually mandate withdrawal of finality in this case.

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Director Stone's May 15 Decision rests primarily on the following two erroneous findings of fact:

(1) "[N]o new ground of rejection was applied by the examiner in the Final Office Action. The 35 USC 101 and 35 USC 112, first paragraph rejections were simply repeated as set forth in the previous Non-Final Office action of September 1, 2000. Specifically, both rejections simply state that the rejections are being maintained for 'the reasons of record' without any additional stated basis for the rejections (emphasis in original); [Decision at 1] and

(2) "While the statement in the Petition that the examiner incorporated additional reasoning in the Final rejection of the claims is correct, this was done solely to answer the substance of the applicant's traversal of the response dated March 1, 2001 to the Non-final Office action." [Decision at 2.]

These erroneous findings not only conspicuously lack citation to, and support in, the record, but more noticeably fail to address the specific grounds on which Applicant's original Petition was based showing the opposite is true. Due process, at a minimum, requires that the PTO speak directly to those grounds, including, but not limited to, the following:

**The Secret Committee's additional reasoning incorporated into its Final Rejection of claims did not answer the substance of Applicant's traversal**

Applicant's original Petition and First Request for Reconsideration discuss in considerable detail how the Secret Committee, now charged with prosecuting the subject application, never considered experimental data and other technical evidence that had been of record for almost four years prior to issuing its Final Office Action. The only reason the Committee finally considered some of that evidence, thereby raising new issues, was because Applicant criticized its previous failure to do so.<sup>1</sup>

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<sup>1</sup> Applicant further cited numerous examples of new state-of-the-art books and journals that were relied upon by the Secret Committee and newly minted

In her May 15 Decision, Director Stone does not even attempt to dispute these facts,<sup>2</sup> much less address the merits of Applicant's argument. Instead, she completely ignores them in concluding without support that the Committee incorporated additional reasoning in its Final Rejection "solely to answer the substance of the applicant's traversal of the response dated March 1, 2001 to the Non-final Office action." That conclusion, however, is blind to the fact that the "substance" of Applicant's traversal included the Secret Committee's failure to consider his record evidence and the Committee "answered" by looking at, and commenting on, that evidence for the first time in its Final Office Action.

Applicant's original Petition and First Request for Reconsideration pointed out this fact in forcefully arguing why making that action Final was blatantly unfair and contrary to PTO procedures outlined in MPEP § 706.07(a). The May 15 Decision merely compounds the PTO's unfair treatment of Applicant by refusing to even consider and address the merits of those arguments.

Instead, the Decision cites a different passage of the MPEP, section 707.07(f), which, when read in the factual context of this case, exposes the impropriety of the Secret Committee's Final Action:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

After an Office action, the reply (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed. If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record,

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arguments that also could have and should have been presented earlier so as to develop a clear issue prior to appeal.

<sup>2</sup> Because the PTO does not dispute any of the facts presented in Applicant's Petition, they must be accepted as true.

he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised. [Decision at 2.]

This passage applies to a situation where the Applicant, in reply to the substance of an Office Action that addressed his prior assertions, includes supplemental arguments or affidavits pointing out deficiencies in that Action. Then, perhaps, the subsequent Office Action in response would be properly made final. That situation, however, contrasts sharply with the present case where Applicant, in reply to the lack of substance of the Secret Committee's first Office Action, pointed out its failure to address his prior assertions, i.e., the scientific evidence of record. In such a case, it is pure folly to suggest that the Committee's newly presented nonenablement arguments in response to that criticism were submitted "solely to answer the substance of the applicant's traversal."<sup>3</sup> [Decision at 2.]

Because the record does not support that finding, the finality of the July 3, 2001 Office Action must be deemed premature and therefore withdrawn.

**Committee arguments that did not merely respond to arguments presented by Applicant constitute a new ground of rejection**

Based on the erroneous finding that the Secret Committee submitted new nonenablement arguments "solely to answer the substance of the applicant's

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<sup>3</sup> Thus, contrary to the May 15 Decision, the 35 U.S.C. §§ 101 and 112, first paragraph, rejections were not "simply repeated as set forth in the previous Non-Final Office action of September 1, 2000." Director Stone's further reliance on the Final Office Action statement that "the rejections are being maintained for 'the reasons of record' without any additional stated basis for rejections" does not make it so. A fair and honest consideration of Applicant's original Petition requires a more sophisticated analysis of the facts than that.

traversal," the May 15 Decision summarily concludes that the Committee therefore did not advance a new ground of rejection:

The arguments put forth by the examiner do not constitute a new ground of rejection in that they merely respond to arguments presented by applicant and do not change the basis for the rejections (i.e. the rejections are still based on lack of utility and enablement as set forth in the previous office action. [Decision at 1.]

Applicant's showing, however, that the Secret Committee did much more than "merely respond to arguments presented by applicant" exposes the fallacy in concluding that the Committee's arguments do not constitute a new ground of rejection

Furthermore, the mere fact that the final rejections of record were "still based on lack of utility and enablement," i.e., 35 U.S.C. §§ 101 and 112, first paragraph, is entirely irrelevant to whether the finality of those rejections was proper. Applicant raised precisely this point in his original Petition and First Request for Reconsideration, yet did not receive the courtesy of a reply.

The PTO's silence on that point is understandable as its own procedural authority highlights the bankruptcy of its position. See, for example, MPEP § 706.07(a) ["Final Rejection, When Proper on Second Action"], which recognizes that a new ground of rejection does not require raising a new rejection under a different statutory provision.

Indeed, situations of arise in which a subsequent Office Action raising a new substantive basis for a rejection, even under precisely the same statutory provision as a prior Office Action, must be made non-final. For example, a second Office Action introducing an obviousness rejection under 35 U.S.C. § 103 based upon a newly cited prior art combination that was not necessitated by amendment could not be made final simply because the claims were previously rejected for obviousness under the same statutory provision. See MPEP § 706.07(a).

Rejections issued under Sections 101 and 112 are certainly no different and, therefore, should be afforded the same treatment. In refusing to acknowledge this procedural reality, the PTO committed fundamental error, requiring that it reconsider and grant Applicant's Petition to withdraw the finality of the July 3 Office Action.

Conclusion

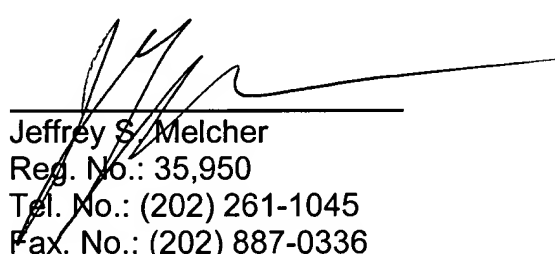
Applicant has shown that the May 15 Decision on Petition rests upon erroneous findings of fact and misapplication of established PTO procedures. Accordingly, the PTO improperly denied Applicant's reasonable request that the finality of the July 3, 2001 Office Action be withdrawn as premature. A modified Decision granting that request is therefore earnestly solicited.

Please charge any required petition fees to our deposit account No. 50-0687, under order No. 62226.

Respectfully submitted,

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